



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,702	10/05/2001	Hajime Takei	018656-252	1791

7590 08/17/2006

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

MURPHY, DILLON J

ART UNIT	PAPER NUMBER
----------	--------------

2625

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/970,702	Applicant(s) TAKEI ET AL.	
	Examiner Dillon J. Murphy	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2625

DETAILED ACTION

In view of the request for a pre-appeal conference filed on May 8, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Kimberly Williams.

KAW Williams

Kim -

Please authorize
reopening of case
after pre-appeal
conference.

~D

Claim Objections

Claim 15 is objected to because of the following informalities: It appears that claim 15 was improperly claimed as depending from claim 5 rather than claim 14. The examiner conducted an informal telephonic interview on August 7, 2006 with James LaBarre (28632) and he informed me that claim 15 was intended to depend from claim 14. The examiner is now rejecting claim 15 as dependent from claim 14. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (US 7061636) in view of Hansen (6509974).

Regarding claim 1, Ryan teaches:

A printing system comprising a print server and printer, as well as an off-line finishing device (fig 5, print monitor controller (PMC) #100 as server, printing devices #201, #202, and #203, for example, with offline finishing devices #42, #45, and #46 of fig 3, wherein the print server (operation occurs in PMC) includes:

First memory means for storing specifications of the printer and of the finishing device as well as information regarding options installed thereon (col 12, ln 26-31,

Art Unit: 2625

wherein memory is inherent to store input printer capabilities and assembler/finisher capabilities);

Receiving means for receiving data pertaining to a job ticket that includes at least finishing specifics for printing to be executed (col 12, ln 32-37, wherein data is received with print parameters and finishing attributes);

Sorting means for, based on the information regarding the specifications and installed options that is stored in the first memory means, separating the finishing specifics included in the job ticket received by the receiving means into those to be performed by the printer and those to be performed by the finishing device (col 19, ln 9-19, for example, wherein job attributes are used to sort printer and finisher capabilities to generate a list of all possible specific paths, i.e. to separate the finishing specifics into those to be performed by the printer and those to be performed by the finishing device);

Setting means for setting, in the printer, the parameters for the finishing specifics separated as by the sorting means and assigned to the printer (fig 5, and col 13, ln 46-50, wherein printer #202 and finishing module #202a are integrated. Job tickets with finishing functions such as collation, stapling, and simple binding may be performed by printer #202, and the job parameters are set in the printer for the required job. Offline assembler/finishing modules #403 receive a separate job ticket from the finishing control module #700 in fig 5. Thus, finishing specifics are sorted and separated into those to be performed by respective devices); and

Creating means for creating data for a finishing device job ticket that includes the finishing specifics separated by the sorting means and assigned to the finishing device

Art Unit: 2625

(col 12, ln 41-62, wherein finishing specifics are separated by PMC and a finishing device job ticket (Virtual finishing job ticket VFJT #102) is created, while sorted and separated print job ticket (Virtual printing job ticket VPJT #101) is created for a printer).

Ryan does not disclose expressly a printing system including an online client, while also not expressly disclosing receiving data pertaining to a job ticket from a client. Hansen, however, teaches an online client (Hansen, fig 1a, client PC in the print shop client) sending data to a server pertaining to a job ticket (jobs received by a print server contain "flags/attributes," column 18, lines 29-35, which specify production output device instructions and parameters, as well as other finishing steps which may or not be automated, column 11, lines 64-67 and column 12, lines 1 and 2. Also see fig 1a, wherein client PC submits order to print shop)

Ryan and Hansen are combinable because they are from a similar field of endeavor of printing and finishing with job tickets. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the client PC of Hansen with the system of Ryan comprising a server that comprises memory means, receiving means, sorting means, setting means, and creating means. The suggestion for doing so was given by Ryan in col 12, ln 32-33, wherein print files are received from an external source, and fig 5, wherein document creating application #1 submits a job. Additionally, it is well known in the art to use a client in a printing system to submit a job to a server. Therefore, it would have been obvious to combine Hansen with Ryan to obtain the invention as specified in claim 1.

Regarding claim 2, which depends from claim 1, the combination of Ryan and Hansen teaches a printing system wherein the print server further includes transmitting means for transmitting to the printer the data pertaining to the finishing device job ticket created by the creating means so as to print the finishing device job ticket (Ryan, col 14, ln 19-64, wherein Job Segment Identifiers JSI are printed (ln 31-32). JSI comprise finishing job specifics, i.e. a finishing device job ticket. Also see col 15, ln 2-9).

Claim 4 recites identical features as claim 1 except claim 4 is an apparatus claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 4. Additionally see Ryan, fig 1 for Production Monitor Controller PMC #100.

Claim 5 recites identical features as claim 2 except claim 5 is an apparatus claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 5.

Claim 7 recites identical features as claim 1 except claim 7 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 7 because without a computer readable medium to store a program that makes it possible for the apparatus to operate, the apparatus taught by Ryan and cited the rejection for claim 1 could not function. Additionally see Hansen, column 8, lines 47-58 and column 7, lines 20-24 for a computer program and medium disclosed.

Claim 8 recites identical features as claim 2 except claim 8 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 8.

Claim 10 recites similar features as claim 1 except claim 10 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 10. A memory and processor are inherent to the operation of the system as taught by Ryan and Hansen.

Claim 11 recites similar features as claim 2 except claim 11 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 11.

Claim 13 recites similar features as claim 1 except claim 13 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 13. A memory and processor are inherent to the operation of the system as taught by Ryan and Hansen.

Claim 14 recites similar features as claim 2 except claim 14 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 9, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Hansen and further in view of Jeyachandran et al. (US 6567176).

Regarding claim 3, which depends from claim 2, the combination of Ryan and Hansen teaches a printing system comprising a server that comprises memory means, receiving means, sorting means, setting means, creating means, and transmitting means. Furthermore, the combination additionally teaches second memory means for storing job information and user information included in the job ticket received by the receiving means (Hansen saves documents and all of the associated tickets, column 12, lines 24-26. Saving occurs on print server #116, Document Library #114, and on computer workstation #114 of Figure 1a. Additionally, user information is inherently saved and included in the job ticket, as evidenced by the use of the CIP3 format in col 12, ln 31-32); and reading means for reading the job information from the data obtained by reading via the scanner the finishing device job ticket printed by the printer (Ryan, fig 5, virtual finishing job ticket reader (VFJTR) #701 for reading job segment identifiers, i.e. finishing device job ticket printed by the printer).

The combination of Hansen and Ryan does not disclose expressly a system further comprising notifying means for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information. Jeyachandran, however, teaches a printing system with notifying means for calling the user information stored in the second memory means based on the job information read by the reading means

Art Unit: 2625

and notifying the client of job completion based on the user information (Jeyachandran, scanner reads in job and job information, transmits data to printer to be printed, and once printing is completed, notifies user that instructed job was performed based on information stored in memory, column 21, lines 7-15 and column 20, lines 46-52).

Ryan, Hansen, and Jeyachandran are combinable because they are from a similar field of endeavor of job ticket based printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the notifying means of Jeyachandran with the printing system of Ryan and Hansen comprising a server that comprises memory means, receiving means, sorting means, setting means, creating means, transmitting means, a second memory, and reading means. The motivation for doing so would have been to alert the user when the print job is done, thereby freeing the user from having to check for a completed print job when there may be not there. Therefore, it would have been obvious to combine Jeyachandran with the combination of Ryan and Hansen to obtain the invention as specified in claim 3.

Claim 6 recites identical features as claim 3 except claim 6 is an apparatus claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 6.

Claim 9 recites identical features as claim 3 except claim 9 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 9.

Claim 12 recites similar features as claim 3 except claim 12 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 12.

Claim 15 recites similar features as claim 3 except claim 15 is broader in the scope of the claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 15.

Response to Arguments

Applicant's arguments, see the Pre-Appeal Request for Review, filed May 8, 2006, with respect to the rejection(s) of claim(s) 1, 2, 4, 5, 7, and 8 under 35 U.S.C. 102e and with respect to claims 3, 6, and 9-15 under 35 U.S.C. 103a have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ryan et al. (US 7061636), Hansen (US 6509974) and Jeyachandran et al. (US 6567176).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Robinson et al. reference (US 20020080402) is cited for teaching a printing system and method using job tickets for printing and finishing operations.

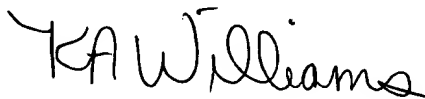
Art Unit: 2625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJM



**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**